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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,980	10/04/2001	David B. Weiner	UPN-4105	4113

7590

12/04/2002

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EXAMINER

BROWN, STACY S

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 12/04/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/971,980

Applicant(s)

WEINER ET AL.

Examiner

Stacy S Brown

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's preliminary amendment is acknowledged and entered. Claims 1-44 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 6 and 7, drawn to a method of inducing cell death comprising contacting a cell with a capsid *protein*, classified in class 514, subclass 2.
 - II. Claims 1-5 and 8, drawn to a method of inducing cell death comprising introducing into a cell a *polynucleotide* encoding a capsid protein, classified in class 514, subclass 44.
 - III. Claims 9-17, drawn to a method of identifying compounds, classified in class 435, subclass 5.
 - IV. Claims 18, 20, 21, 37 and 38, drawn to a pharmaceutical composition comprising capsid *protein*, classified in class 424, subclass 184.1.
 - V. Claims 18-19, 39 and 40, drawn to a pharmaceutical composition comprising a *polynucleotide* encoding a capsid protein, classified in class 536, subclass 23.72.
 - VI. Claims 22, 24, 26-28 and 30, drawn to a method of treating cancer comprising administering a capsid *protein*, classified in class 514, subclass 2.
 - VII. Claims 23 and 25, drawn to a method of treating cancer comprising administering a *polynucleotide* encoding a capsid protein, classified in class 514, subclass 44.
 - VIII. Claims 29 and 31-36, drawn to a method of identifying an individual exposed to a virus, classified in class 435, subclass 5.

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- IX. Claims 41-44, drawn to a method of treating and protecting against viral infection comprising administering a capsid *protein*, classified in class 514, subclass 2.
- X. Claims 41-44, drawn to a method of treating and protecting against viral infection comprising administering a *polynucleotide* encoding a capsid protein, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

- a) The methods of Groups I-II, IV-V, VI-VII and IX-X are distinct because they require either protein or nucleic acid. These products are structurally distinct and are used differently in the methods.
- b) Groups I-III, VI-X are all unrelated methods, drawn to methods of inducing cell death, treating cancer, identifying patients exposed to virus, treating and protecting against infection. These methods are not disclosed as capable of used together and they have different functions, modes of operation and effect.
- c) Inventions IV-V and (I-III, VI-X) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products, a capsid protein product and polynucleotide encoding the same, can be used in materially different methods such as inducing cell death, treating cancer, identifying individuals exposed to virus, treating and protecting against viral infection.

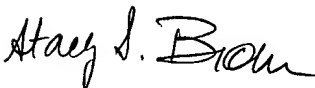
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Because these inventions are distinct for the reasons given above and the literature search required for one group is not co-extensive with any other group and therefore burdensome, restriction for examination purposes as indicated is proper.

Conclusion

Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1648 is (703) 308-4426. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Stacy S. Brown, whose telephone number is (703) 308-2361. The Examiner can normally be reached on Monday through Friday and alternate Wednesdays from 6:30 AM-4:00 PM, (EST). If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, James C. Housel, can be reached at (703) 308-4027. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Stacy S. Brown
November 30, 2002



HANKYEL T. PARK, PH.D
PRIMARY EXAMINER